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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,445	09/25/2006	Yu Sing Hooi	09170.0002U1	7585

23859 7590 08/13/2008
Ballard Spahr Andrews & Ingersoll, LLP
SUITE 1000
999 PEACHTREE STREET
ATLANTA, GA 30309-3915

EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

MAIL DATE	DELIVERY MODE
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08/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,445	Applicant(s) HOOI, YU SING	
	Examiner Karin M. Reichle	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/21/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The preliminary amendment filed 6-12-06 has been accepted. However such does not comply with 37 CFR 1.121 in that all the changes made to claim 25 have not been properly shown nor is the parenthetical with regard to claim 26 proper, i.e. --(Cancelled)--. The next response, if any, must comply with 37 CFR 1.121.

Specification

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sheath opening through the pad, the pad layers, the sheath tube layers as claimed in claims 1-15 and 18-25 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

3. The abstract of the disclosure is objected to because the abstract is too long, i.e. more than 150 words in length. Also, terminology which can be inferred, i.e. "This invention relates to", and legal terminology, i.e. "comprises", should be avoided. Correction is required. See MPEP § 608.01(b).

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the abstract, line 2 and page 1, line 7.

5. The disclosure is objected to because of the following informalities: 1) Reference to the "applicant", e.g., page 3, line 2, should be avoided. 2) With regard to page 5, line 5, see MPEP 608.01(o), i.e. "The use of a confusing variety of terms for the same thing should not be permitted". 3) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims are not commensurate in scope, see MPEP 608.01(d).

Appropriate correction is required.

Claim Objections

6. Claims 1-23 and 25 are objected to because of the following informalities: In the claims “worn”, all, should be --wearable--. Claim 3 is missing a word or words. With regard to claim 25, see discussion in the following paragraph. The preamble of this claim which depends from claim 1 should be “The sanitary product of claim is manufactured by the method comprising--, on line 2, “an”, both, should be --the-- and on line 3, “a ...1” should be --the sheath--. Appropriate correction is required.

Claim Language Interpretation

7. The claim terminology is interpreted in light of the definitions on page 4, line 25-page 5, line 1 (It is noted that such does not require wearing entirely inside or outside) and page 8, lines 18-20. Any other claim language not specifically defined has been interpreted in view of the usual and common meaning of such, e.g. the dictionary definition. Claim 25 is considered a claim depending from claim 1 and thereby a product by process claim, see MPEP 2113.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 7-14, 16-18, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lloyd EP’039.

Claim 1: See Claim Language Interpretation section *supra*, hereinafter also referred to as CLI, and '039 at the Figures, esp. 1-4B, page 27, line 8-page 31, last line, page 4, lines 3-11, page 15, lines 16-27, page 10, lines 15-20, the paragraph bridging pages 14-15, page 15, first full paragraph, page 16, lines 1-17, page 17, lines 1-6 and 14-22, page 18, line 1-page 19, line 14, page 20, line 1-page 21, line 9, and page 22, line 19-page 24, last line, i.e. '039 teaches a sanitary product for insertion into a human vagina which includes an internally worn absorbent plug, e.g., at least a portion of 11, and an externally worn absorbent pad, e.g. 6, joined to one another by a sheath 2, 3 that opens through the pad, see, e.g., Figures, esp. 4A and/or page 21, lines 5-9, such that a wearer's finger can be received in the sheath to assist insertion, see, e.g., page 15, lines 11-15 or page 29, lines 13-16.

Claim 2: See, e.g., page 17, lines 1-6 and page 19, lines 1-11, i.e. the sheath is liquid impermeable in a direction from the outside of the sheath to the inside of the sheath.

Claim 3: See discussion of claims 1-2, i.e. the sheath comprises tube of liquid impermeable material.

Claim 7: See page 20, lines 7-8 and page 24, lines 12-15, i.e. the sheath comprises a tube of absorbent material.

Claim 8: See overlapping tubular portions of 12, in Figures 1-1A, 2-2A, 3-3A, 4-4B, page 17, lines 1-6, page 18, lines 12-17, page 20, lines 3-8, page 24, last paragraph, i.e. the sheath comprises a tube of liquid impermeable material inside a tube of absorbent material.

Claim 9: See, e.g., page 27, lines 17-18, i.e. "flexible", i.e. the sheath is flexible.

Claim 10: See Figure 2B adjacent the arrow from 2 or page 24, last paragraph, i.e. the sheath has a smaller diameter than that of the plug.

Claim 11: See the paragraph bridging pages 14-15, the first full paragraph on page 15, and page 16, line 10 and page 17, line 17, i.e. the sheath can be expandable in a radial direction to receive a finger during insertion of the product into the vagina and can be made of resilient materials, i.e. elastomers, knits.

Claim 12: See Figure 1B and page 15, lines 16-27, i.e. the sheath extends for substantially 2.5 cm between an end of the plug and a surface of the pad closest to the plug with “sufficient specificity”, see MPEP 2131.03.

Claims 13-14: See Figures, i.e. the product further comprises a cord 7 attached to the plug to assist removal of the plug from the vagina which cord extends along the inside of the sheath.

Claim 16: See discussion of claim 1, i.e. a sanitary product comprising an absorbent plug for insertion into a vagina, an externally worn absorbent pad and a neck/sheath joining the plug and the pad, and the paragraph bridging pages 14-15 and MPEP 2131.03, i.e. ‘039 teaches the plug 11 is substantially 4 cm in length or less and/or 2 cm in diameter or smaller with “sufficient specificity”. Note also page 12, lines 7-9 of the instant specification.

Claim 17: See discussion of claim 12 supra.

Claims 18 and 24: See discussion of claim 1 supra.

Claim 25: See CLI supra and the discussion of claim 1, i.e. the product of claim 1 is manufactured by joining an internally worn absorbent plug to an externally worn absorbent pad by a sheath.

10. Claims 1, 3-6, 24, 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaysersberg ‘405.

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Claim 1: See Claim Language Interpretation section *supra*, hereinafter also referred to as CLI, and '405 at the Figures, esp. 3-4 and 6, the English abstract, the paragraph bridging pages 8-9, page 5, second to last paragraph, page 9, first full paragraph, the paragraph bridging pages 7-8 and the first full paragraph of page 8, i.e. '405 teaches a sanitary product for insertion into a human vagina which includes an internally worn absorbent plug, e.g., at least a portion of 44, 444, and an externally worn absorbent pad, e.g. 2, joined to one another by a sheath 66 that opens through the pad, see, e.g., Figures, such that a wearer's finger can be received in the sheath to assist insertion, see, e.g., the paragraph bridging pages 8-9.

Claim 3: See cited portions in discussion of claim 1, i.e. the sheath 66 comprises a tube of liquid impermeable material.

Claims 4-5: See cited portions in discussion of claim 1, i.e. the pad 2 comprises an absorbent layer 7 and a liquid impermeable backing sheet 99 and the backing sheet is integral with the liquid impermeable material of the sheath, see Figure 3.

Claim 6: The sheath passes liquid along its length from the plug to the pad, see English abstract.

Claim 24: See discussion of claim 1 *supra*.

Claim 25: See CLI *supra* and the discussion of claim 1, i.e. the product of claim 1 is manufactured by joining an internally worn absorbent plug to an externally worn absorbent pad by a sheath.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 15 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd '039 in view of Phelps '234, and Denkinger '372.

Claims 15 and 19-20: See discussion of claim 16 supra, i.e. the diameter of the plug is 2 cm or less, 1.5 cm or less or 1.5 cm, respectively, with "sufficient specificity". These claims further require the plug be substantially 4 cm in length or less, substantially 3.5 cm in length or less or substantially 3.5 cm in length, respectively. While '039 suggests such lengths, e.g. see page 15, lines 24-27 and the Figures, '039 does not explicitly teach such. However, note page 12, lines 7-11 of the instant specification, as well as '234 at col. 2, lines 55-58 and '372 at col. 1, lines 64-65 and col. 3, lines 12-15, i.e. the prior art desires the same properties/combination of properties as the instant application, i.e. a portion which is absorbent and sized for wear internally in the vagina as well as length/size being a result effective variable or specific sizes within the claimed ranges. Note also MPEP 2141.05. Therefore, even if the prior art does not include the exact length, the general conditions of the claim are disclosed thereby and it is not inventive, i.e. it would be obvious to one of ordinary skill in the art, to discover the optimum or workable ranges, i.e. Applicant's ranges, by routine experimentation, In re Aller, 105 USPQ 233 (CCPA 1955).

13. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaysersberg '405 in view of Ohba PCT'611 and Denkinger '372.

Claim 21: This claim requires an external portion, i.e. pad, have the shape of a flat ellipse with one end wider than the other. While page 11, lines 25-26 of '405 teach the external absorbent portion may be rectangular, oblong, sandglass or other shape it does not teach the claimed specific shape. However, see '611 at page 6, lines 10-13 and Figures 3-7 of '372, esp. Figure 7, i.e. interchangeability of shapes of external absorbent portions similar to '405 for those claimed, i.e. ellipsis with different sized ends. To make the shape of '405 the claimed shape instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by '611 and '372.

Claims 22-23: These claims require the pad be substantially 6.5cm long and 5.5cm wide or substantially 0.5cm thick, respectively, which '405 does not teach. However, see '611 at page 6, lines 18-30 and '372 at col. 3, lines 12-18 as well as page 13, lines 7-13 of the instant specification, i.e. the prior art desires the same properties/combination of properties as the instant application, i.e. a portion which is absorbent and sized for comfortable wear externally as well as length/width/caliper/size being result effective variables and/or specific sizes within the claimed ranges. Note also MPEP 2141.05. Therefore, at the very least the general conditions of the claim are disclosed thereby and it is not inventive, i.e. it would be obvious to one of ordinary skill in the art, to discover the optimum or workable ranges, i.e. Applicant's ranges, by routine experimentation, *In re Aller*, 105 USPQ 233 (CCPA 1955).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art also teach various disclosed/claimed features or combinations thereof. It is also noted that it appears the '405 reference also teaches at least some of the other of the features set forth claims 2, and 7-23. The Examiner is awaiting a complete translation of '405 since one was not provided.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Karin M. Reichle/
Primary Examiner, Art Unit 3761

August 7, 2008